

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 36

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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***Ex parte*** MIREILLE MAUBRU

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Appeal No. 2003-0617  
Application No. 09/319,164

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HEARD: June 11, 2003

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Before PAK, OWENS, and POTEATE, ***Administrative Patent Judges.***

POTEATE, ***Administrative Patent Judge.***

***DECISION ON APPEAL***

This is an appeal under 35 U.S.C. § 134 from the examiner's refusal to allow claims 39-102, which are all of the claims pending in the application.

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Claim 39 is representative of the subject matter on appeal and is reproduced below:

39. A ready-to-use composition for the oxidation dyeing of keratin fibers, comprising:

- at least one oxidation base,
- at least one ether chosen from C<sub>4</sub>-C<sub>8</sub> ethers of C<sub>2</sub> glycols and C<sub>1</sub>-C<sub>8</sub> ethers of C<sub>3</sub>-C<sub>9</sub> glycols,
- at least one enzyme chosen from 2-electron oxidoreductases, and
- at least one donor for said at least one enzyme.

The references relied upon by the examiner are:

Tsujino et al. (Tsujino)	4,961,925	Oct. 9, 1990
Cotteret	5,391,206	Feb. 21, 1995
Wella Aktiengesellschaft (Wella) (European patent)	EP 795,313	Sept. 17, 1997

#### **GROUND OF REJECTION**

1. Claims 39-102 stand rejected under 35 U.S.C. § 103 as unpatentable over Cotteret in view of Tsujino.

2. Claims 39-102 stand rejected under 35 U.S.C. § 103 as unpatentable over Wella in view of Cotteret.

We reverse as to both grounds of rejection.

### **BACKGROUND**

The present invention relates to a composition for the oxidation dyeing of keratin fibers such as hair. Specification, page 1, lines 3-5. It is known in the art to dye keratin fibers with dye compositions containing oxidation dye precursors such as ortho- or para-phenylenediamines, ortho- or para-aminophenols and heterocyclic bases. *Id.* at lines 13-18. When combined with oxidizing products, these precursors may give rise to colored compounds and dyes through a process of oxidative condensation. *Id.* at lines 20-22. The resultant shades of color can be varied by combining the oxidation bases with couplers or color modifiers. *Id.* at lines 23-25.

Prior art processes for the oxidation dyeing of keratin fibers are typically carried out in an alkaline medium in the presence of hydrogen peroxide. *Id.*, page 2, lines 17-19. A drawback of using an alkaline medium in the presence of hydrogen peroxide is that it causes appreciable degradation of the fibers as well as considerable bleaching of the fibers, which may not be desirable. *Id.* at lines 19-23. The inventors have discovered that it is possible to obtain dyes which are capable of providing

intense and chromatic colorations without giving rise to significant degradation of the fibers by combining at least one oxidation base, at least one C<sub>4</sub>-C<sub>8</sub> ether of a C<sub>2</sub> glycol and/or at least one C<sub>1</sub>-C<sub>8</sub> ether of C<sub>3</sub>-C<sub>9</sub> glycol and at least one enzyme of 2-electron oxidoreductase type in the presence of at least one donor for the enzyme. *Id.*, page 3, lines 13-24.

#### **DISCUSSION**

The initial burden of presenting a ***prima facie*** case of obviousness rests on the examiner. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). In order to establish a ***prima facie*** case of obviousness, the examiner must identify a suggestion or motivation to modify the teachings of the cited references to achieve the claimed invention. *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000). The suggestion or motivation to modify a reference may be implicit from the prior art as a whole rather than expressly stated. *Id.* However, regardless of whether the examiner relies on an express or implicit showing, he must provide reasons for finding a limitation to be taught or suggested in the reference. *Id.*

**1. Rejection of claims 39-102 under 35 U.S.C. § 103  
as obvious over Cotteret in view of Tsujino**

Cotteret discloses a hair dye composition which includes an oxidation base, hydrogen peroxide and either ethylene glycol monobutyl ether or propylene glycol monomethyl ether. Tsujino is relied on for a disclosure of a hair dye composition which utilizes an enzyme/donor system. According to the examiner, it would have been obvious to have substituted the hydrogen peroxide of Cotteret with the enzyme/donor system of Tsujino. See Appeal Brief, Paper No. 28, received September 3, 2002, page 5. According to the examiner, the motivation to modify Cotteret's composition is found in Tsujino's disclosure of decreased skin irritation while maintaining equivalent dyeing properties when hydrogen peroxide is replaced with an enzyme/donor system. See Examiner's Answer, Paper No. 29, mailed November 15, 2002, page 4 (referencing Tsujino's test data).

As pointed out by appellants, Cotteret and Tsujino have conflicting pH requirements. See Reply Brief, Paper No. 30, received January 22, 2003, page 5. Cotteret teaches that, "[t]he pH of the composition applied to the keratinous fibers, in particular the hair, has a value of below 7 and is preferably

between 3 and 6.9." Column 3, lines 37-39. In contrast, Tsujino's compositions are adjusted to a minimum of pH 7. Thus, while Tsujino suggests that equivalent dyeing properties may be achieved when hydrogen peroxide is replaced with an enzyme/donor system in an alkaline environment, there is no evidence that compositions containing enzymes would provide equivalent or better effects on finish or dyeing properties at a pH below 7, i.e., Cotteret's required pH. As further pointed out by appellants, Cotteret does not indicate that reduced skin irritation is of concern, or a desired objective in regard to his hair dye composition. See Appeal Brief, page 13.

Given the conflicting pH requirements of Cotteret and Tsujino and the absence of any discussion of skin irritation problems in Cotteret, we cannot agree with the examiner that one of ordinary skill in the art, in considering Cotteret's composition, would have been motivated to replace hydrogen peroxide with an enzyme/donor system as taught by Tsujino. Accordingly, the rejection is reversed.

**2. Rejection of claims 39-102 under 35 U.S.C. § 103  
as unpatentable over Wella<sup>1</sup> in view of Cotteret**

Wella discloses compositions comprising an oxidation base, an enzyme, a donor and 1,2-propanediol and glycerol. See Appeal Brief, page 18. According to the examiner, it would have been obvious to have substituted the propanediol and/or glycerol with a glycol ether, such as the presently claimed propylene glycol monomethyl ether because Cotteret teaches the equivalence of propanediol and glycol ethers in oxidative hair dying compositions. **See *id.***, pages 18-19; Examiner's Answer, page 6.

As correctly pointed out by appellants, the fact that Cotteret may establish the equivalence of the solvents for one purpose is not sufficient to establish their equivalency for all

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<sup>1</sup>The examiner's rejection is based upon a German language document. Neither the examiner nor appellants have obtained English translations of this document. Rather, appellants reference U.S. Patent No. 5,849,041 which they believe to be the U.S. counterpart to Wella. See Appeal Brief, page 18, footnote 1. The examiner has not objected to appellants' reliance on this document in traversing this rejection. Moreover, the relevant portions of the German language document appear to correspond with the U.S. counterpart. Accordingly, we have concluded that it is unnecessary to remand this application to the examiner to consider the full text translation of the European patent document relied upon in the rejection. In the future however, the examiner should obtain a full text translation of any foreign language document relied upon in rejecting the claims.

purposes. See Appeal Brief, pages 19-21. As further noted by appellants, the Federal Circuit has expressly declined to adopt a ***per se*** rule that the disclosure of a chemical genus renders obvious the selection of any species that happens to fall within it. See Appeal Brief, page 22 (***citing In re Jones***, 958 F.2d 347, 350, 21 USPQ2d 1941, 1943 (Fed. Cir. 1992)). The examiner has simply failed to identify any teaching or suggestion in the prior art which would have motivated one of ordinary skill in the art to have substituted the propanediol and/or glycerol of Wella's compositions with one of the claimed glycol ethers.

Accordingly, the rejection is reversed.



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In sum, we reverse the rejections on the basis that the examiner has failed to establish a ***prima facie*** case of obviousness.

***REVERSED***

CHUNG K. PAK	)	
Administrative Patent Judge	)	
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	)	BOARD OF PATENT
TERRY J. OWENS	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
LINDA POTEATE	)	
Administrative Patent Judge	)	

LRP:psb

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